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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,378	11/28/2000	Timothy V. Updyke	0942.5640006/LEA/RLP	3471

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EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT

PAPER NUMBER

1753

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,378

Applicant(s)

UPDYKE ET AL.

Examiner

ALEX NOGUEROLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 67-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Double Patenting Rejections Based on U.S. Patent No. 6,059,948

2. Claims 67, 71, and 73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,059,948. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of U.S. Patent No. 6,059,948 meets all the limitations of claims 67, 71, and 73 of the instant application. For claim 71 note that since the Applicant's claimed gel is the same as that taught by claim 3 the properties will be the same for both gels.

3. Claim 68 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,059,948. Claim 67, from

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which claim 68 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the adjective “precast” does not further structurally (or compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the gel, for example, does not structurally alter the gel.

4. Claim 69 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,059,948 in view of Sambrook et al. (Molecular Cloning: A Laboratory Manual 2nd ed.). Claim 6 does not mention any particular types of electrophoresis gels. It would have been obvious to one with ordinary skill in the art at the time the invention was made to use an agarose gel because it is a very commonly used gel for electrophoresis and as taught by Sambrook et al. “agarose gel electrophoresis is both forgiving and adaptable” (page 6.8).

5. Claim 70 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claim 3 and claim 6 of U.S. Patent No. 6,059,948. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of claims 3 and claim 6 of U.S. Patent No. 6,059,948 meets all the limitations of claim 70 of the instant application.

Double Patenting Rejections Based on U.S. Patent No. 6,096,182

6. Claims 67, 71, and 73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,096,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of U.S. Patent No. 6,096,182 meets all the limitations of claims 67, 71, and 73 of the instant application. For claim 71 note that since the Applicant's claimed gel is the same as that taught by claim 3 the properties will be the same for both gels.

7. Claim 68 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,096,182. Claim 67, from which claim 68 depends, has been addressed above. Although the conflicting claims are not identical, they are not patentably distinct from each other because the adjective "precast" does not further structurally (or compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the gel, for example, does not structurally alter the gel.

8. Claim 69 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,096,182 in view of Sambrook et al. (Molecular Cloning: A Laboratory Manual 2nd ed.). Claim 3 does not mention any particular types of electrophoresis gels. It would have been obvious to one with ordinary skill in

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the art at the time the invention was made to use an agarose gel because it is a very commonly used gel for electrophoresis and as taught by Sambrook et al. "agarose gel electrophoresis is both forgiving and adaptable" (page 6.8).

9. Claim 70 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claim 3 and claim 5 of U.S. Patent No. 6,096,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of claims 3 and claim 5 of U.S. Patent No. 6,096,182 meets all the limitations of claim 70 of the instant application.

Double Patenting Rejections Based on U.S. Patent No. 5,578,180

10. Claims 67, 68, and 70-73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,578,180. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of U.S. Patent No. 5,578,180 meets all the limitations of claims 67 and 69 of the instant application. For claim 71 note that since the Applicant's claimed gel is the same as that taught by claim 2. the properties will be the same for both gels.

Claim Rejections - 35 USC § 112

11. Claims 67-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Independent claim 67 requires a gel having a pH between 6 and 8, wherein the gel comprises bis(2-hydroxyethyl)iminotris(hydroxymethyl)methane. The original disclosure, however, only provides support for a gel in a *gel buffer* having a pH between 6 and 8, wherein the *gel buffer* comprises bis(2-hydroxyethyl)iminotris(hydroxymethyl)methane.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 67, 68, 71, and 73 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Clayton et al. ("Amine-Citrate Buffers for pH Control in Starch Gel Electrophoresis," Journal of the Fisheries Research Board of Canada (1972), 29(8), 1169-72). See the abstract; Figure 3; and Table 1. For claim 68 note that the adjective "precast" does not further structurally (or

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compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the gel, for example, does not structurally alter the gel. For claim 71 note that since the Applicant's claimed gel is the same as that taught by Clayton et al. the properties will be the same for both gels.

Claims 67-69, 71, and 73 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Guadagno et al. (US 5,171,410). See the abstract; claims 2 and 10; and column 4, lines 5-17. For claim 68 note that the adjective "precast" does not further structurally (or compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the gel, for example, does not structurally alter the gel. For claim 71 note that since the Applicant's claimed gel is the same as that taught by Guadagno et al. the properties will be the same for both gels.

13. Claims 67, 68, and 71 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Ratliff et al. ("Purification of a mycobacterial adhesion for fibronectin," Infection and Immunity (1993), 61(5), 1889-94). See the abstract. For claim 68 note that the adjective "precast" does not further structurally (or compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the gel, for example, does not structurally

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alter the gel. For claim 71 note that since the Applicant's claimed gel is the same as that taught by Ratliff et al. the properties will be the same for both gels.

14. Claims 67, 68, 70, and 71 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wiltfang et al. ("A new multiphasic buffer system for sodium dodecyl sulfate-polyacrylamide gel electrophoresis of proteins and peptides with molecular masses 100 000-1000, and their detection with picomolar sensitivity," *Electrophoresis* (1991), 12(5), 352-66). See the abstract; the comb gel composition listed in the section entitled *2.3.2 SDS-Page of naondansylated proteins/peptides* on page 354 of the article; and *Appendix 6.2*. For claim 68 note that the adjective "precast" does not further structurally (or compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the gel, for example, does not structurally alter the gel. For claim 71 note that since the Applicant's claimed gel is the same as that taught by Wiltfang et al. the properties will be the same for both gels.

15. Claims 67, 68, 71, and 72 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schroeder et al. ("Chromatography of Hemoglobins on CM-Cellulose with Bis-Tris and Sodium Chloride Developers," *Journal of Chromatography*, 118(1976) 295-302). See the abstract and the subsections entitled *Solutions* and *Preparation of ion exchanger* on page 296. For claim 68 note that the adjective "precast" does not further structurally (or compositionally) modify the claimed gel. That the gel was made by somebody other than the current user of the


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gel, for example, does not structurally alter the gel. For claim 71 note that since the Applicant's claimed gel is the same as that taught by Schroeder et al. the properties will be the same for both gels.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (703) 305-5686. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Alex Noguerola
May 24, 2003